

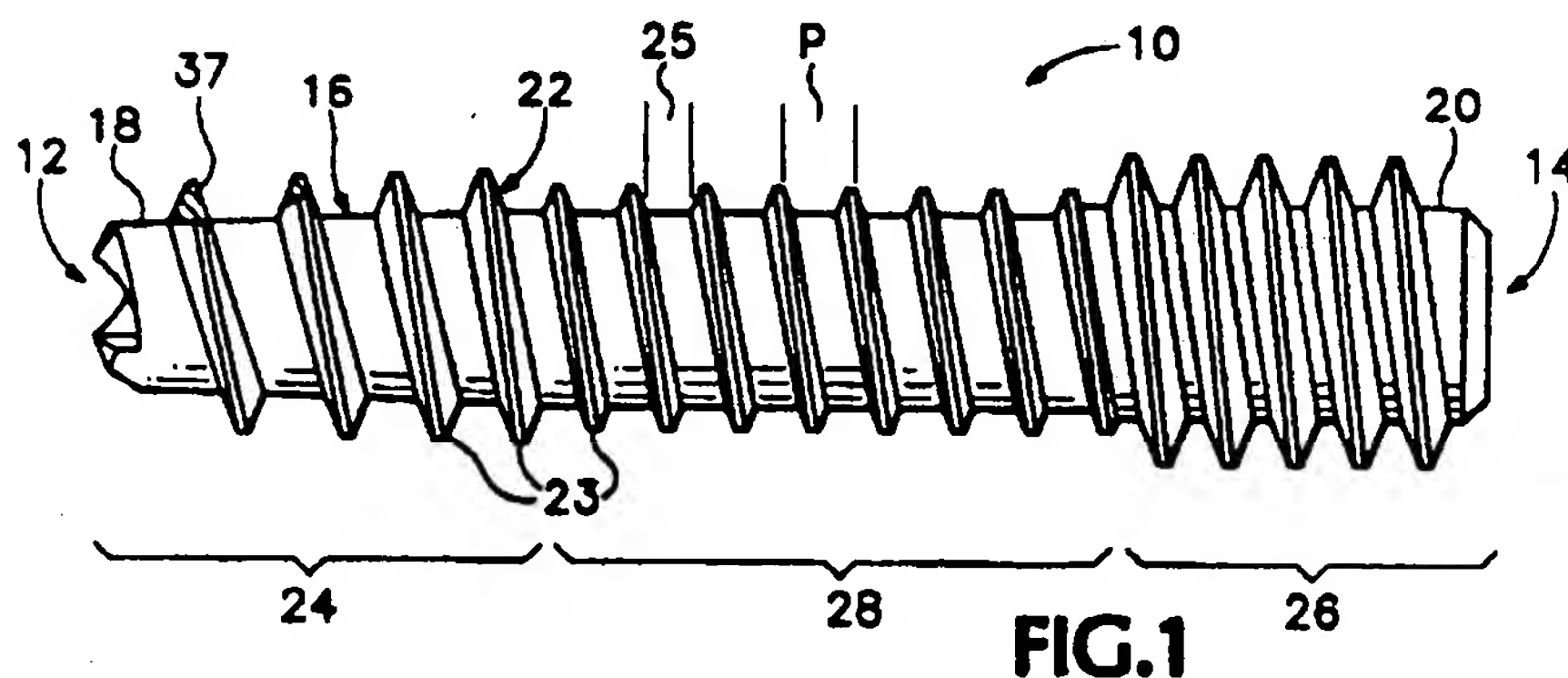
REMARKS

The above-identified application has been reviewed in light of the Office Action mailed on June 16, 2006. By the present amendment, the Applicants have amended claims 21, 23, 24, and 26, and have canceled claims 22 and 29-31. It is respectfully submitted that the claims pending in the application are fully supported by the specification, introduce no new matter, and are patentable over the prior art.

The Office Action objected to the specification. According to the Office Action, the disclosure included minor informalities. The Applicants have amended the specification as suggested by the Examiner to correct the typographical errors. It is respectfully submitted that the objection to the specification has been overcome.

In the Office Action, claims 21-24 and 27 were rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 6,030,162 to Huebner (the '162 patent). The Office Action stated that the '162 patent discloses a surgical tack having a head with a drive thread formed on an outer surface of the head, a barrel portion extending from the head, a tissue engaging thread formed on an outer surface of the barrel, and a throughbore extending through the head and the barrel portion for receipt of a drive tool.

As shown below in Figure 1, the '162 patent discloses a screw 10 having a front end 12,



a back end 14, and a root portion 16 located therebetween. Root portion 16 has a leading end 18 and a trailing end 20 which are coextensive with the leading end and trailing end of the screw 10. In addition, the '162 patent discloses that the screw 10 includes a screw thread 22 formed on the root portion 16. According to the '162 patent (Column 3, lines 36-38), "[a] screw thread 22 is formed on root portion 16 and extends as a single continuous thread from the leading end to the trailing end." The '162 patent specifically discloses the use of a **single continuous** thread on the disclosed screw and fails to disclose or suggest that "the drive thread and the tissue engaging thread are discontinuous" as recited in amended claim 21. Therefore, the '162 patent fails to disclose or suggest a surgical tack including, *inter alia*, a tissue engaging thread and a drive thread wherein "the drive thread and the tissue engaging thread are discontinuous," as recited in amended claim 21. It is respectfully submitted that the rejection of the Office Action has been overcome and that claim 21 is in condition for allowance. Claim 22 has been canceled and it is respectfully requested that the rejection of this claim be withdrawn. Since claims 23, 24, and 27 depend from amended claim 21, it is respectfully submitted that these claims are also in condition for allowance.

In the Office Action, claim 26 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over the '162 patent. According to the Office Action, the '162 patent fails to disclose a chamfered drive thread on the head portion, but discloses a chamfer on the leading section. The Office Action asserted that it would have been obvious to add a chamfered portion to the head portion.

As discussed hereinabove, the '162 patent fails to disclose or suggest the surgical tack recited in amended claim 21. Since claim 26 depends from independent claim 21, it is

Appl. No. 10/517,402
Amdt. dated September 6, 2006
Reply to Office Action Mailed June 16, 2006

respectfully submitted that the rejection of the Office Action has been overcome and that claim 26 is in condition for allowance.

In the Office Action, claims 25 and 28 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over the '162 patent in view of U.S. Patent No. 5,169,400 to Mühling et al. (the '400 patent). The Office Action stated that the '162 patent discloses a throughbore, but fails to disclose that the throughbore has a D-shaped cross-section. According to the Office Action, it would have been obvious to modify the throughbore of the '162 to include a shape that better applies the torque of an insertion tool as disclosed in the '400 patent.

As discussed hereinabove, the '162 patent fails to disclose or suggest the surgical tack recited in amended claim 21. Adding the non-circular throughbore of the '400 patent fails to cure the deficiencies of the '162 patent. The '400 patent fails to disclose or suggest any features that, in combination with the '162 patent, would suggest the surgical tack recited in amended claim 21. Since claims 25 and 28 depend from independent claim 21, it is respectfully submitted that these claims are in condition for allowance.

The Office Action rejected claims 29 and 30 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 5,891,146 to Simon et al. (the '146 patent) in view of the '400 patent. According to the Office Action, the '146 patent discloses a screw having a head, a tapered barrel with a tissue engaging thread formed thereon, and a bore extending through the head and the tapered barrel portion. However, the Office Action acknowledged that the '146 patent fails to disclose a non-circular cross-section and added that feature from the '400 patent. The Office Action stated that it would have been obvious to combine the '146 patent with the '400 patent for the same reasons that were previously discussed with respect to the '162 patent and the '400 patent.

Appl. No. 10/517,402
Amdt. dated September 6, 2006
Reply to Office Action Mailed June 16, 2006

By the present amendment, the Applicants have canceled claims 29 and 30 without prejudice. Therefore, it is respectfully requested that the rejection of these claims be withdrawn.


In the Office Action, claim 31 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over the '162 patent, in view of the '146 patent, and further in view of the '400 patent. The Office Action stated that the '162 patent fails to disclose a tapered barrel portion. The Office Action added the tapered barrel portion of the '146 reference and the non-circular throughbore disclosed in the '400 patent.

By the present amendment, the Applicants have canceled claim 31 without prejudice. Therefore, it is respectfully requested that the rejection of this claim be withdrawn.

Prompt and favorable action on these claims, namely claims 21-28, is earnestly requested. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5713.

Respectfully submitted,

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road - Suite 225
Melville, New York 11747
Tel.: (631) 501-5713
Fax: (631) 501-3526


Dana A. Brussel
Reg. No. 45,717
Attorney for Applicant(s)

Send correspondence to:
Chief Patent Counsel
U.S. Surgical, a Division of
Tyco Healthcare Group
195 McDermott Road
North Haven, Connecticut 06473